REMARKS

Claims 21 – 40 and 50 – 56 are currently pending in the Application. A Request for Continued Examination ("RCE") under 37 C.F.R. §1.114 is being filed herewith. Claims 21, 26, 31, 36 and 54 have been amended. Claims 1 – 20 and 41 – 49 were cancelled in a previous amendment. Support for the amendments to claims 21, 26, 31, 36 and 54 may be found, for example, in the specification at page 6, lines 4 – 12. Accordingly, no new matter has been added to the application by the foregoing amendments.

Applicants note that the claim amendments in this paper are made with respect to the last entered claim amendments submitted with the Applicants' Amendment filed on October 15, 2007. The arguments presented herein are in response to the Final Office Action dated January 8, 2008, except where explicitly noted otherwise.

Claim Rejections – § 102(e)

Claims 54 – 56 are rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent No. 6,724,403 to Santoro et al. (hereinafter "Santoro").

For a rejection under § 102 (e) to be proper, a reference must disclose, either explicitly or inherently, <u>each and every element</u> of the claimed invention. Applicants respectfully submit that Santoro does not teach each and every element recited in independent claim 54.

Independent claim 54, as amended, recites, in relevant part:

> A method of accessing a picture file received from a cellular telephone, said method comprising the steps of:
>
> storing a plurality of picture files on said <u>cellular telephone</u>;...

...displaying a subset of said plurality of picture files on said display according to a selected display function, said subset comprising picture files selected by way of said selection options associated with said plurality of picture files;

enabling access by said first user, remote from said cellular telephone, by way of a webpage provided by a wireless service provider for said cellular telephone, to said plurality of picture files and said information which has been changed; and

enabling a second user to select which picture files of said plurality of picture files are displayed on said webpage by way of said webpage.

At pages 2 – 5 of the Final Office Action and in response to Applicants' previous arguments, the Examiner argues that, in Santoro, "[t]he server and/or the web site is said to be associated, or in communication with the wireless service provider, See fig. 24 and fig. 27." The Examiner also contends that the phrase "webpage associated with a wireless service provider" is broadly construed to mean "in communication with", and therefore, disclosed by Santoro.

Although Applicants believe the Examiner's interpretation of the claim language to be incorrect, to further prosecution of the Application, independent claim 54 (as well as independent claims 21, 26, 31 and 36) have been amended such that the claims now recite "a webpage provided by a wireless service provider."

Santoro does not explicitly or implicitly disclose, "enabling access by said first user...by way of a webpage provided by a wireless service provider for said cellular telephone..." In Santoro, a client side application storing a user's grid profile is in contact with a server. The server may be local or remote to the user. However, Santoro does not suggest that a user is enabled access "remote from said cellular telephone, by way of a webpage provided by a wireless service provider." Initially, Applicants point out that Santoro does not even discuss a wireless service provider, either with reference to Fig. 27 or anywhere else. It appears that the Examiner contends that an Internet Service Provider (e.g., the ISP 2712 in Fig. 27 of Santoro) is the same as a Wireless Service provider. This is simply incorrect. Moreover, to the extent that any aspect of

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Fig. 27 or Santoro could be considered a wireless service provider, there is certainly no teaching of a wireless service provider that hosts both a cell phone and a web page for accessing that cell phone, as recited in independent claim 54. More specifically, in both Fig. 27 and the rest of Santoro, the Internet Service Provider 2712 is completely separate from the servers 2706 and neither gives any suggestion that the servers (or the web pages accessed via the servers) are provided by the Internet Service Provider 2712. Thus, although the servers 2706 in Fig. 27 may be "in communication with" the Internet Service Provider 2712, there is certainly no teaching in Santoro that the ISP 2712 is a wireless service provider that provides a webpage for a cell phone, as recited in independent claim 54. Stated differently, Santoro merely describes a loose communication of elements that are, neither the same elements as nor in the same relationship as those recited in independent claim 54.

As such, each and every element of claim 54 is not disclosed by Santoro. Dependent claims 55 and 56 are allowable at least by their dependency on independent claim 54.

Claim Rejections – § 103(a)

Claims 21-22, 24-27 and 29-49 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Santoro in view of Heather McDaniel, PalmPower Review, Album to Go software (hereinafter McDaniel), and further in view of U.S. Patent No, 6,970,859 to Breachner et al. (hereinafter Breachner). Applicants respectfully traverse this rejection.

The Examiner noted in the Advisory Action that "one cannot show nonobviousness by attacking references individually where the rejections are based on the combination of references." (Examiner's Advisory Action, pg. 2). Respectfully, however, Applicants note that the MPEP requires that for a 103 rejection to be proper, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." (MPEP § 706.02(j)). Applicants' arguments set forth herein and in the Amendment After Final are of course directed to individual references in an effort to explain why those references fail to teach the aspects that the Examiner alleges that they

teach (either individually or in combination). Since the basis for the Examiner's obviousness rejections relies on one of the references teaching a particular element, Applicants' response is appropriately focused on explaining why the Examiner's reading of one particular reference is incorrect. Such explanation or argument does not constitute attacking the references individually in an obviousness rejection, but rather responds to the only place where the Examiner has alleged that a teaching of certain elements exists. With these elements not being taught by the prior art, the combination proposed by the Examiner cannot possibly teach or suggest all of the claimed elements as required by the MPEP.

Claim 21 recites, in relevant part:

> A method of accessing a picture file received from a cellular telephone, said method comprising the steps of:
>
> receiving said picture file at said cellular telephone;...
>
> providing a separate selection option for each picture file of said plurality of picture files when said plurality of picture files is displayed on said cellular telephone;
>
> ...displaying a subset of said plurality of picture files on said display according to a selected display function, said subset comprising picture files selected by way of said selection options associated with said plurality of picture files;
>
> enabling access by said first user, remote from said cellular telephone by way of a webpage provided by a wireless service provider for said cellular telephone, to said plurality of picture files and said information which has been changed; and
>
> enabling a second user to separately select a selection option associated with each picture file of said plurality of picture files displayed on said webpage by way of said webpage.

The combination of Santoro, McDaniel and Breachner does not teach or suggest each and every element of independent claim 21. Most notably, the combination does not

teach "enabling access by said first user, remote from said cellular telephone by way of a webpage <u>provided by</u> a wireless service provider for said cellular telephone, to said plurality of picture files and said information which has been changed." As discussed above with respect to the Examiner's anticipation rejection, in contrast to the system of Santoro, claim 21 (as well as the other independent claims) recites a website that is <u>provided by</u> a wireless service provider.

The above discussion is directed to Santoro because Santoro is the Examiner's primary reference and basis for the combination of Santoro, McDaniel and Breachner teaching the claimed elements. Applicants further note that McDaniel and Breachner also do not teach "a website that is provided by a wireless service provider," nor does the Examiner even allege that McDaniel or Breachner teach this element. Since Santoro, McDaniel and Breachner do not individually teach "a website that is provided by a wireless service provider," the combination of these three references cannot possibly teach or suggest this element. As such, Applicants have not attacked the references individually, but have shown that the combination does not teach or suggest all the claimed elements. Furthermore, the Examiner argues that McDaniel "explicitly discloses a software ... that provides a separate selection option for each picture file of said plurality of picture files when said plurality of picture files [are] displayed on a handheld device." (Final Office Action, pages 11-12). The Examiner cites pg. 2, figs. B and C of McDaniel in support of this notion. However, in responding to Applicants' arguments, the Examiner appears to ignore Applicants' point that these portions of McDaniel all lead to the conclusion that McDaniel does not teach or suggest what the Examiner contends. Rather, McDaniel describes a selection option for one – and only one – picture file. This can plainly be seen in figs. A, B and C of McDaniel. Since McDaniel only displays one picture file at a time, it would therefore be impossible for McDaniel to teach "a separate selection option for each picture file of said plurality of picture files." In contrast, claim 21 recites that several different picture files are displayed on the screen simultaneously and each of these picture files has a "separate selection option for each picture file of said plurality of picture files when said plurality of picture files is displayed." Accordingly, none of McDaniel, Breachner or Santoro teach this feature. Since the Examiner relies on

McDaniel for teaching this feature, the focus of Applicants' response was with regard to McDaniel. The Examiner did not allege that any of the other references teach this feature. As such, Applicants have not attacked the references individually, but rather responded to the only place where the Examiner has alleged a teaching of this element exists. Since none of the references individually teach this element, the combination of these references does not teach or suggest this element.

Additionally, McDaniel does not teach or suggest the a system with the capabilities of a cellular telephone as recited in the claims. The Examiner argues that Qualcomm's pdQ Palm/Cellphone ("pdQ") describes a device that could be used with McDaniel and would satisfy the claim element's requirement for a cellular phone. At the outset, Applicants note that none of McDaniel, Santoro nor Breacher make mention of the PDQ nor the desirability of combining such a device with any of these references. Furthermore, despite the Examiner's contention to the contrary, PDAs, including the pdQ did not have cellular capabilities. The pdQ relied on by the Examiner proves this to be the case. More specifically, Qualcomm's pdQ was simply a device which had two separate modes: a cellular phone mode and a PalmOS mode (see Examiner's attached article pg. 2, "in phone mode ... in PalmOS mode"). As described in the article, the only integration between the Palm OS and the cellular phone is the address book (see Examiner's attached article pg. 3). When using the pdQ, programs running in PalmOS are not available when the pdQ is in cellular phone mode (see fig. A), nor do programs running in PalmOS have any functionality with the cellular phone (see pg. 4). In contrast, claim 21 recites a cellular phone that is able to receive a picture file, and then alter and display these picture files.

Furthermore, there is no evidence that the pdQ could run the album-to-go software, considering that the McDaniel makes no mention of the pdQ and the supplied pdQ reference makes no mention of the album-to-go software. Thus, even if the Examiner's use of the pdQ and/or its combination with Santoro, McDaniel and Breacher is proper, such combination in view of the knowledge of those skilled in the art at the time of the invention still does not teach or suggest all elements of the claimed invention.

Moreover, even if the Qualcomm pdQ did satisfy the requirement of being a cellular phone and could run the album to go software, the combination of Santoro, McDaniel and Breacher still would not sufficiently teach the claimed invention, taking into consideration the claimed invention as a whole. According to MPEP 2141.02(I), "in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." The Examiner contends that the Qualcomm pdQ running the Album-To-Go software would have taught "providing a separate selection option for each picture file of said plurality of picture files when said plurality of picture files is displayed on said cellular telephone." However, claim 21 recites "receiving said picture file at said cellular telephone." As such, the cellular phone in claim 21 necessarily can receive and send pictures. Even if the pdQ were running the Album-To-Go software, the PalmOS portion of the pdQ would be entirely separate from the telephone portion of the pdQ. Thus, even if the pdQ was able to receive a picture file (something that has not been alleged by the Examiner and is not in the cited references), because the PalmOS implementation at the time of the invention was not designed or implemented with cellular phone technology or integration, such a picture file would be received in the telephone portion of the pdQ and would not be able to be used by the Album-To-Go software. Accordingly, when claim 21 is taken as a whole, it is quite clear that McDaniel does not teach "providing a separate selection option for each picture file of said plurality of picture files when said plurality of picture files is displayed on said cellular telephone," regardless of whether or not it could run on a device that was attached to a cellular telephone.

Most importantly, and un-refuted by the Examiner, McDaniel does not explicitly or implicitly teach or suggest that the software could be used for or would be advantageous to be used on a cellular phone. If it were running on the pdQ, there is no evidence that it would take advantage of any of the cellular capabilities of the pdQ, which would be necessary to meet the claim elements. Similar to the argument set forth, Applicants have responded to the Examiner's reading of McDaniel in traversing the rejection, as the Examiner has alleged that this element is taught by McDaniel. The

Examiner did not allege that any of the other references teach this feature. As such, Applicants have not attacked the references individually, but rather responded to the only place where the Examiner has alleged a teaching of this element exists. Since neither McDaniel nor any of the other references teach this element, the combination of these references does not teach or suggest this element.

Independent claims 26 and 31 ("providing a separate selection option for each picture file of said plurality of picture files displayed on a display of said cellular telephone") as well as claim 36 ("enabling the first user to separately designate each said selection option associated with said plurality of picture files") recite similar elements to claim 21, wherein a selection option exists for a plurality of picture files, distinguishing them from McDaniel. Independent claims 26, 31, 36 and 54 all recite using a "cellular telephone" in similar manners as claim 21. For the same reasons discussed above with these elements are not taught by the combination of McDaniel, Santoro and Breachner.

Accordingly, independent claims 21, 26, 31, 36 and 54 are believed to be allowable over the proposed combination of Santoro, McDaniel and Breachner. Dependant claims 22-25, 27-30, 32-35 and 37-40, 50 – 53 and 55 – 56 are believed to be allowable at least by their dependency on independent claims 21, 26, 31, 36 and 54, respectively.

Reconsideration and withdrawal of the Examiner's §103(a) rejections are respectfully requested.

Conclusion

In view of the forgoing amendments and remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 21 – 40 and 50 – 56, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and a Notice of Allowance are respectfully requested.

Respectfully submitted,

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